

REMARKS

The Applicant respectfully requests reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 3, 15, 18, 28 and 56 have been amended.

Claims 35-55 have been cancelled.

Claims 68-69 have been added to present claims of varying scope.

Claims 1-34 and 56-69 are now pending.

This amendment adds, changes and/or deletes claims in this Application. A detailed listing of claims that are, or were, in the Application, irrespective of whether the claim(s) remain under examination in the Application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-14, 15-27 and 56-67

On pages 1-5 and 6-8 of the Office Action the Examiner rejected Claims 1-14, 15-27 and 56-67 as being obvious over U.S. Patent No. 6,434,873 titled “Ornamental Display for Achievement Awards” to Pierce (“Pierce ‘873”) or U.S. Patent No. 4,556,588 titled “Decorative Emblem Useful in Customizing an Automobile and Other Surfaces” to Rockwood (“Rockwood ‘588”) in view of U.S. Patent No. 6,517,168 titled “Wheel Cover Having Interchangeable Turbine Pocket Inserts” to Van Houten (“Van Houten ‘168”) under 35 U.S.C. § 103(a).

The Examiner stated that:

[Pierce ‘873] teaches a decorative display such as a medallion (col. 5, lines 53-63) comprising a cavity wherein the insert is placed into the space defined by the cavity. The insert may be an embossed paper, embossed cardboard, embossed plastic, stamped metal sheet, a hologram and combinations thereof.

The Examiner also stated that:

[Rockwood ‘588] teaches an emblem made of two parts, a base and a capped inlay. The base may be provided with depression to retain the inlay. See col. 2, lines 39-58. The reference teaches a rim may be provided around the base and the inlay may be sapped into place in the base member. The inlay may be a graphic bearing

or embossed and may be in different shapes. See col. 3, lines 1-11 and lines 32-34.

However, the Examiner acknowledged that Pierce '873 or Rockwood '588 do not “require a plurality of inserts (three sets) having different characteristics” (Claims 1-14 and 15-27) and “do not require a first, second and third set of inserts” (Claims 56-67).

The Examiner stated that Van Houten '168 discloses:

An article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets is disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

The Examiner concluded that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the medallion of [Pierce '873] or the emblem of [Rockwood '588] by providing a plurality of interchangeable inserts having different shapes, color, outline and placing the plurality of the interchangeable inserts in the cavity or depression of the base of the medallion of [Pierce '873] or emblem of [Rockwood '588] as taught by [Van Houten '168] [in order] to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.

Rockwood '588 is directed to a “decorative emblem” that is “made of two parts, the base member 14 and the capped inlay 12” (emphasis added) (col. 3, lines 1-3; and Figures 1 and 2).

Pierce '873 is directed to “an ornamental display” that “comprises front and back panels, where each panel has peripheral edges, an insert, a cavity, and fastening means” (emphasis added) (col. 1, lines 42-45; and Figures 1-3).

Van Houten is directed to a “wheel cover having interchangeable turbine pocket inserts” including “interchangeable inserts snapped into turbine pockets of a wheel cover”

(emphasis added) (see Background of the Invention, at col. 1, lines 23-24; and Figures 1-4). Van Houten '168 provides that “[t]he pocket insert 50 includes a circumferential periphery 52 that generally corresponds to the shape of the turbine pockets 28 of the wheel cover 20” (see col. 5, lines 42-44; and Figures 1-4). As shown in Figure 1 of Van Houten '168, (only) one insert is disposed within each pocket (see Figure 1). Van Houten '168 is directed to “[a] wheel cover assembly having an array of pocket inserts correspondingly disposed within an array of turbine pockets of a wheel cover” (see Abstract; and Figures 1-4).

Claim 1 (as amended) is in independent form and recites a “medallion for association with a motor vehicle” comprising, in combination with other elements, “inserts installed within the base having different ornamental appearances” selected from a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics.” The “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased (e.g., see Claim 3). Claims 2-14 depend from independent Claim 1 (as amended).

Claim 15 (as amended) is in independent form and recites a “set of articles for association with motor vehicles” comprising, in combination with other elements, “sets of inserts” comprising a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics.” The “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased (e.g., see Claim 18). Claims 16-27 depend from independent Claim 15 (as amended).

Claim 56 (as amended) is in independent form and recites “in a system for forming a medallion comprised of a base and inserts” the improvement comprising, in combination with other elements, a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics.” The “visible characteristics are

associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased (e.g., see Claim 68). Claims 57-68 depend from independent Claim 56 (as amended).

The “medallion for association with a motor vehicle” recited in independent Claim 1 (as amended), the “set of articles for association with motor vehicles” recited in independent Claim 15 (as amended), and the improvement “in a system for forming a medallion comprised of a base and inserts” recited in independent Claim 56 (as amended) would not have been obvious in view of Pierce ‘873 or Rockwood ‘588, alone or in any proper combination with Van Houten ‘168 under 35 U.S.C. § 103(a). Pierce ‘873 or Rockwood ‘588 alone or in any proper combination with Van Houten ‘168 do not disclose, teach or suggest the “medallion for association with a motor vehicle” recited in independent Claim 1 (as amended), the “set of articles for association with motor vehicles” recited in independent Claim 15 (as amended), and the improvement “in a system for forming a medallion comprised of a base and inserts” recited in independent Claim 56 (as amended) comprising, in combination with other elements, “inserts installed within the base having different ornamental appearances” selected from a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” (Claim 1), “sets of inserts” comprising a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” (Claim 15), and a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” (Claim 56) wherein the “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased. To transform the “Decorative Emblem Useful in Customizing an Automobile and Other Surfaces” of Rockwood ‘588 or the “Ornamental Display for Achievement Awards” of Pierce ‘873 and the “Wheel Cover Having Interchangeable Turbine Pocket Inserts” of Van Houten ‘168 into the “medallion

for association with a motor vehicle” recited in independent Claim 1 (as amended), the “set of articles for association with motor vehicles” recited in independent Claim 15 (as amended), and the improvement “in a system for forming a medallion comprised of a base and inserts” recited in independent Claim 56 (as amended) would require still further modification, and such modification is taught only by the Applicant’s own disclosure. The suggestion to make the combination of Pierce ‘873 or Rockwood ‘588 with Van Houten ‘168 has been taken from the Applicant’s own specification (using hindsight), which is improper.

For a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue (e.g., In re Dow Chemical, 837 F.2d 469 (Fed. Cir. 1988); see also M.P.E.P. § 2143.03). The recitation in Van Houten ‘168 of a wheel cover providing for “multitudes of different decorative wheel appearances” (Abstract) or that “the turbine pockets 28 may take on any number of various geometries so that many different ornamental designs can be provided” (col. 5, lines 19-22), along with the disclosures of Pierce ‘873 and Rockwood ‘588, do not teach, suggest or disclose, in combination with other elements, “inserts installed within the base having different ornamental appearances” selected from a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” (Claim 1), “sets of inserts” comprising a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” (Claim 15), and a “first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” (Claim 56) wherein the “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased. These limitations, among others, are not disclosed, taught, or suggested by the cited references (including Van Houten ‘168).

The “medallion for association with a motor vehicle” recited in independent Claim 1 (as amended), the “set of articles for association with motor vehicles” recited in independent Claim 15 (as amended), and the improvement “in a system for forming a medallion comprised of a base and inserts” recited in independent Claim 56 (as amended), considered as a whole, would not have been obvious in view of Pierce ‘873, Rockwood ‘588 and/or Van Houten ‘168. The rejection of Claims 1, 15 and 56 over Pierce ‘873 or Rockwood ‘588 in view of Van Houten ‘168 under 35 U.S.C. § 103(a) is improper. Therefore, Claims 1, 15 and 56 are patentable over Pierce ‘873 or Rockwood ‘588 in view of Van Houten ‘168.

Dependent Claims 2-14 which depend from independent Claim 1, dependent Claims 16-27, and dependent Claims 57-68 are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 1-27 and 57-67 under 35 U.S.C. § 103(a).

Claims 28-34

On pages 5-6 of the Office Action the Examiner rejected Claims 28-34 as being obvious over U.S. Patent No. 6,517,168 titled “Wheel Cover Having Interchangeable Turbine Pocket Inserts” to Van Houten (“Van Houten ‘168”) under 35 U.S.C. § 103(a).

The Examiner stated that:

[Van Houten ‘168] teaches an article such as a wheel cover for a vehicle having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries (which may be interpreted as characteristic of different shapes) so that many different ornamental designs can be provided. See col. 5, lines 15-22.

However, the Examiner acknowledged that Van Houten ‘168 does not “require a first set, a second set and a third set of inserts.”

The Examiner concluded that:

Since [Van Houten '168] teaches interchangeable inserts may be provided it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a plurality set of inserts in order to provide a unique ornamental appearance for the article.

Claim 28 (as amended) is in independent form and recites an “article” comprising, in combination with other elements, “a first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics.” The “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased (see Claim 69). Claims 29-34 and 69 depend from independent Claim 28 (as amended).

The “article” recited in independent Claim 28 (as amended) would not have been obvious in view of Van Houten '168, alone or in any proper combination under 35 U.S.C. § 103(a). Van Houten '168 alone or in any proper combination does not disclose, teach or suggest an “article” comprising, in combination with other elements, “a first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” wherein the “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased. To transform the “Wheel Cover Having Interchangeable Turbine Pocket Inserts” of Van Houten '168 into an “article” (as recited in Claim 28) would require still further modification, and such modification is taught only by the Applicant’s own disclosure. The suggestion to make the modification of Van Houten '168 has been taken from the Applicant’s own specification (using hindsight), which is improper.

For a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue (e.g., In re Dow Chemical, 837 F.2d 469

(Fed. Cir. 1988); see also M.P.E.P. § 2143.03). The recitation in Van Houten '168 of a wheel cover providing for “multitudes of different decorative wheel appearances” (Abstract) or that “the turbine pockets 28 may take on any number of various geometries so that many different ornamental designs can be provided” (col. 5, lines 19-22) does not teach, suggest or disclose, in combination with other elements, “a first set of inserts having at least two visible characteristics,” a “second set of inserts having at least two visible characteristics,” and a “third set of inserts having at least two visible characteristics” wherein the “visible characteristics are associated with objective features of a customer profile” including sales information, purchaser name, purchaser address, number of vehicles purchased, date of purchase, vehicle identification number, and model purchased. These limitations, among others, are not disclosed, taught, or suggested by Van Houten '168 (or any of the cited references).

The “article” recited in independent Claim 28, considered as a whole, would not have been obvious in view of Van Houten '168. The rejection of Claim 28 over Van Houten '168 under 35 U.S.C. § 103(a) is improper. Therefore, Claim 28 is patentable over Van Houten '168.

Dependent Claims 29-34 and 69, which depend from independent Claim 28, are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 28-34 under 35 U.S.C. § 103(a).

New Claims 68 and 69

New dependent Claims 68 and 69 have been added and are intended to recite subject matter that is patentable over the cited references used in the rejection of the claims in the present Office Action. Claim 68 depends from independent Claim 56. Claim 69 depends from independent Claim 28.

The Applicant believes that the present Application is now in condition for allowance. Favorable reconsideration of the Application as amended is respectfully requested.

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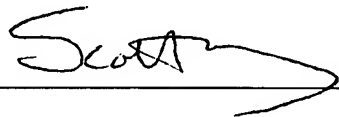
The Applicant respectfully submits that each and every outstanding objection and rejection has been overcome, and the present Application is in a condition for allowance. The Applicant requests reconsideration and allowance of pending Claims 1-34 and 56-69.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present Application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this Application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to the Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extension fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 10/29/04

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